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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HUSEMAN, MARIANNE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/576,462

Applicant(s)

THOMPSON ET AL.

Examiner

Marianne Huseman

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. The declarations filed on 1/28/02 under 37 CFR 1.131 are sufficient to overcome the From2.com reference. However, the specific declaration regarding the parts list and the modification of the Excel spreadsheet is not understood; i.e., a description as to how they relate to the development of this invention should be provided. This specific declaration was not considered in the determination of sufficiency.

#### ***Information Disclosure Statement***

2. As this Application has been examined under a Petition to make special due to infringement, it is respectfully requested that Applicants' supply the infringing reference and/or information regarding the infringing product. Applicants' in their Request to make special stated that there was presently on the market an infringing product. The reference given on the IDS of 2/15/01, does not appear to be the infringing reference; that U.S. Patent was filed in 1997 with a provisional filing date of 1996. See 37 CFR 1.105.

#### ***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 41 (second occurrence) through 59, as well as their dependency, if applicable, have been renumbered (42 – 60, respectively) in order to bring them into compliance with the above rule. The claims below refer to the newly renumbered claims (42 – 60).

#### ***Specification***

4. The disclosure is objected to because of the following informalities: There also appears to be no disclosure for customizing the database, claim 38, nor disclosure for "at least one product identifier ... unique to a particular company", claims 27, 28, 39, 40, 46 and 47. There is also no disclosure for scanning invoice data, claim 54, in

Applicants' specification. Appropriate correction is required. No new matter will be entered.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 56 - 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear as to how the limitations of claim 1 and its representative invention can import/export a product into a country using a data record as claimed in claims 56 – 58. Importing/exporting a product is considered to be a physical action not an action performed by a computer.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 60 (renumbered) are rejected under 35 U.S.C. 103(a) as being unpatentable over Chelliah et al in view of Bonney (periodical).

Regarding claims 1, 10, 19, 24, 41, 42 and 48: Chelliah et al, figure 2, teach a computer system for electronic commerce such that Applicants' invoice data reads on transaction items (column 10, lines 63 - 65), Applicants' first terminal reads on element 142 (column 10, lines 31 – 43), Applicants' server reads on element 144 (column 11, lines 19 – 39), Applicants' step of matching reads on column 12, lines 43 – 50, figure 7, wherein it is disclosed that the items/selection list (product identifier) are matched against the pricing rules (tariff classification information) and Applicants' data record reads on Chelliah et al's receipt (column 18, line 24).

Although Chelliah et al do not specifically teach the use of tariff classification codes in their database, element 120, for the import/export of products, Bonney teaches

an international e-commerce system wherein shipping/custom charges associated with a product are looked-up using computerized tariff classifications. Chelliah et al uses the pricing engine to determine any price alterations, such as discounts and promotions. The Examiner is broadly interpreting the pricing engine as also capable of storing tariff classification codes, which like discounts and promotions, will affect the ultimate price of the item. Chelliah et al further discloses that their "engines" are modules which can be altered, see columns 7 and 8, lines 64 – 67 and lines 1 – 44, respectively. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use the computerized tariff classification codes as taught by Bonney in Chelliah et al's Price Cost Engine, element 120, so that Chelliah et al can accommodate the unique shipping charges when shipping internationally in addition to the ability of calculating the national shipping charges disclosed by Chelliah et al, thereby expanding his customer base. See also, Chelliah et al, column 8, lines 47 – 50, with regard to using another implementation of a computer based shipping calculator.

Regarding claims 2 and 11: Applicants' second terminal reads on element 12. Although Chelliah et al do not specifically teach e-mailing the data record (receipt), as Chelliah et al teaches communication by way of an on-line service it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit a data record or receipt using e-mail as that practice is old and well-known.

Regarding claims 3 – 5, and 12 - 14: As interpreted by the Examiner, Applicants' downloading reads on Chelliah et al's displaying of a receipt (data record) to the customer. Also, while Chelliah et al do not specifically teach printing the data record, it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made for the customer to print out a copy of the data record if a "hard copy" is desired using the standard keyboard "PrtScn" button.

Regarding claims 6, 15 and 29: Applicants' electronic transmission of invoice data reads on the communication between element 142 (as well as elements 12 and

13) and element 144. See Chelliah et al, column 10, lines 56 – 68 and column 11, lines 1 – 3.

Regarding claims 7 and 16: Applicants' web site reads on the disclosure of Chelliah et al at column 12, lines 1 – 9.

Regarding claims 8, 17, 21 and 31: Although neither Chelliah et al nor Bonney specifically teach how the database is updated, it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the capability of updating the price engine, tax engine and shipping engine as the values therein are more than likely to change over time. See also, Chelliah et al, column 11, lines 63 – 68, wherein it is disclosed that the "enterprise responsible for the compartment has access" (third terminal) and claims 13 and 14. See also Bonney, the 25<sup>th</sup> and 35<sup>th</sup> paragraphs.

Regarding claims 9 and 18: Applicants' transaction database reads on element 128 and the recording of results reads on the merchant copy of the customer's receipt (data record).

Regarding claim 20: Applicants' web link reads on column 12, lines 1 – 9.

Regarding claim 22: Although neither Chelliah et al nor Bonney specifically teach transforming a data record into a customs report for transmittal to a customs entity, it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit such a record (or receipt) to a customs entity if you are shipping the items listed in the record, internationally.

Regarding claim 23: Although neither Chelliah et al nor Bonney specifically disclose a program operable for updating the database, databases, when updated, are inherently updated by some type of program.

Regarding claim 26: Applicants' third web page reads on the web page of, for example, the FedEx on-site shipping calculator taught by Chelliah et al and the discussion of claim 24 above. See Chelliah et al, column 8, lines 45 – 50 and Bonney, 21<sup>st</sup> paragraph.

Regarding claims 27, 28, 32, 38 – 40, 45 – 47 and 49: Bonney, 21<sup>st</sup> paragraph, teaches that an importer can put their parts numbers (unique) into the database.

Regarding claims 30 and 44: See Chelliah et al, column 18, lines 12 – 24, wherein it is stated that the invoice contains a listing of the items (product identifier) to be bought.

Regarding claim 33: See Bonney, 18<sup>th</sup> paragraph.

Regarding claim 34: Although not specified by either Chelliah et al or Bonney, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to create such a report as this report is necessary for dealing with customs.

Regarding claim 35: Sorting data entries is considered to be old and well known.

Regarding claim 36: Creating a master report is interpreted as the final invoice receipt, kept by the Sales Representative, element 142, of Chelliah et al.

Regarding claims 37 and 60: Although Bonney does not specify split screening, but rather switching between screens, the ability to display a plurality of windows, via a split screen is considered to be an old and well-known technique and therefore is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to alter your display so that you would not have to switch among different screens.

Regarding claims 43, 50, 52 and 55: Bonney discloses updating/modifying the database if there are changes in tariffs or rules. See Bonney, 25<sup>th</sup> paragraph. See also the discussion above, with regard to claim 27.

Regarding claims 51, 53 and 56: See the discussion of claims 1 and 34, above. Regarding sending the master report to a government customs office, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention for Chelliah et al, in view of Bonney, to send the report (receipt) onto any applicable entities such as a government customs office as would be required in international deliveries.

Regarding claim 54: The step of scanning as a means of inputting data is old and well-known. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to scan invoice data into a computer rather than input that data directly to the computer via keyboard or data transfer

(computer to computer), if the invoice data was computed by hand or by another unconnected computer.

Regarding claims 58 and 59: Applicants' data record reads on the receipt of Chelliah et al. It is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention for Chelliah et al, upon shipping internationally, to use that receipt/invoice (in view of the teachings of Bonney) to facilitate the shipping of that product to the customer as receipts/invoices are a necessary part of importing products.

### ***Response to Arguments***

9. Regarding Applicants' step of inputting the invoice data, including a product identifier identifying a product to be transported in the transaction, into a database, claims 7 and 16, the Examiner is interpreting that any product (identifier) listed/purchased (data input) in the invoice of Chelliah et al will be shipped to the customer. The database is read as Chelliah et al's pricing engine and the web site is interpreted as the merchant (elements 142 and 144).

With regard to Applicants' request for references teaching "emailing", "downloading" and "printing", Applicants' have stated in their arguments that "the use of email to transmit ... data records and receipts may be old and well-known", but that it is not old and well-known upon the step of matching. Please note that in the new rejection above, the Examiner states that Applicants' matching step is interpreted as being equivalent to the matching performed by Chelliah et al. Upon Chelliah et al matching the pricing (from a database) of the items selected by the user, Chelliah et al displays the results (total cost) to the user on the user's display (monitor). Please note also that the user has the ability to print these results using the "PrtScn" button available on standard keyboards, and, "downloading" (as the term appears to be used by Applicants) of this information is interpreted as the act of the merchant displaying the result of the matching step to the user's display (element 12). References regarding "e-mailing" are provided in this action.



**Conclusion**


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fortenberry et al, Sharp et al and Tobin are cited as disclosing the e-mailing of receipts/purchase orders. Falic et al (From2.com) teach a database for storing and retrieving tariff codes and rules for purposes of pricing international shipping.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

  
Marianne Huseman  
Examiner  
Art Unit 2161

mh  
April 22, 2002